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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1964

No. 869

IN THE MATTER OF THE
APPLICATION OF HOMER G. THOMSON

REPLY OF PETITIONER TO BRIEF OF RESPONDENT

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1. Respondent's "Question Presented" (Res. 2) wholly misstates this case. Petitioner has not made any contention that the CCPA "considered evidence which had not been produced before the Patent Office." There is no question that the patents relied on by the CCPA are a part of the record, wherefore respondent's erroneous presentation of the case requires reply.

Petitioner contends that the CCPA made unsupportable findings new to the case and employed the Kohring patent, whereas the Patent Office had not so employed Kohring, in creating a new reason for rejection never stated in the Patent Office (Pet. 7-8). Respondent agrees when he states (Res. 5) "* * * the court relied on patents other than those considered dispositive by the Board of Appeals * * * it articulated its reasons for rejecting petitioner's claims differently than did the Patent Office * * *."

Hence, the question is presented whether the CCPA is authorized to propound and rely upon reasons for rejection not raised below and not preserved in the Reasons of Appeal.

2. The issue before the CCPA is *not* as respondent contends (Res. 5), the same as that before the Patent Office. Respondent's argument makes reference to only a part of 35 USC 144. The statute also requires that "the decision shall be confined to the points set forth in the reasons of appeal." Hence the review of the CCPA is restricted only to a determination whether the reasons of rejection stated by the Patent Office are correct.

The questions presented in this case concern very substantial problems of the nature of review by the CCPA. The review of that court is unique, for it is based upon a specific statute and must be compatible with proceedings in the Patent Office. As the CCPA declared in a very recent decision:

> "* * * These, however, are new arguments never used in making the rejection and if they are to be relied on we think they should be made in the Patent Office where appellant has the opportunity to answer them as contemplated by the statute, 35 U.S.C. 132, and the rules, Rule 104(b), and not presented to him for the first time in this court. This court is a court of *review* and reasons for rejection not made in the Patent Office are not properly before us." *In re Nygard*, 52 CCPA —; — F. 2d —; 144 USPQ 586 (CCPA March 4, 1965)

Respondent's arguments are incompatible with the complete statute and the foregoing quotation. The treatment of petitioner's application for patent by the CCPA also has not been in accord with the statute and the quotation, wherefore the Petition herein should be granted.

3. The correlated questions of (i) whether reliance by the CCPA on new reasons for rejection deprives petitioner of a fundamental right to be heard, and (ii) whether the CCPA can perform an administrative function, assigned to the Patent Office, of creating reasons for rejection are both sidestepped in respondent's brief. Respondent's arguments do not meet the *real* Constitutional and statutory issues presented for decision by this Court.

Respectfully submitted,

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